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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,726	01/30/2004	Hidehiko Ogawa	P24504	6085

7055 7590 09/27/2006

GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER
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LEE, TOMMY D

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/767,726

Applicant(s)

OGAWA, HIDEHIKO

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/461,402.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/1/04, 7/6/04, 3/4/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/461,402, filed on December 15, 1999.

### *Specification*

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 7,095,524 (Ogawa). Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of the claims in the application read on the limitations of the patent.

For example, claim 1 of the application reads as follows:

An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:

a memory configured to store a default mail address and a mail address of at least one user;

a panel section configured to select the mail address of at least one user other than the default mail address stored in the memory; and

a controller configured to set the default mail address into the mail message of the e-mail to which the image data is attached when the mail address of the user is not selected by the panel section;

the controller being configured to set the mail address of the user selected by the panel section into the mail message of the e-mail to which the image data is attached when the mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus.

Claim 1 of the patent, by comparison, reads as follows (common language in boldface):

**An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data attached to the e-mail as an openable document, the image data communication apparatus comprising:**

**a memory configured to store** default information, information regarding an identification of at least one user of the image communication apparatus, **a default e-mail address, and an e-mail address of the at least one user;**

**a panel configured to select the** information regarding an identification of at least one user and **the e-mail address of the at least one user** other than the default information and **other than the default e-mail address stored in the memory; and**

**a controller configured to set** the default information and **the default e-mail address into the mail message of the e-mail to which the image data is attached when** the information regarding the identification of the user and **the e-mail address of the user are not selected by the panel;**

**the controller being configured to set** the information regarding the identification of the user and **the e-mail address of the user selected by the panel into the mail message of the e-mail to which the image data is attached when** the information regarding the identification of the user and **the e-mail address of the user are selected by the panel, whereby** opening, at the receiving apparatus, of the

attached image data is not required to determine the information regarding the identification of the user, and **the e-mail address** set into the mail message of the e-mail **can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus.**

By comparing the two claims, it is clear that each and every limitation of application claim 1 is recited in patent claim 1, and thus application claim 1 is clearly anticipated by patent claim 1. By comparing the remaining claims of the application and the patent, it is clear that each of the remaining application claims 2-45 is anticipated by corresponding claims 2-45 of the patent.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,742,769 (Lee) in view of U.S. Patent 5,798,845 (Baek).

Regarding claims 1-27, Lee discloses an image data communication apparatus connected to an image data source and to a network, and transmitting an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message (column 7, lines 26-39), the image data communication apparatus comprising: a panel section configured to select the mail address of at least one user (in order to log in, a user enters the e-mail address and password for authentication);

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and a controller being configured to set the mail address of the user selected by the panel section into the mail message of the e-mail when the mail address of the user is selected by the panel section, whereby the mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail (user's e-mail address copied into "reply-to" field (column 7, lines 36-40), thereby enabling reply to the mail address of the user without requiring input of the mail address of the user at the receiving apparatus), the reply being sent from the receiving apparatus (column 7, lines 51-59). The panel comprises a personal computer connected to the image data communication apparatus and displaying an HTML document for storing the mail message of the user in the memory (PENTIUM®-based personal computer running on a 32-bit operating system such as Windows NT (column 3, lines 23-28).

Lee does not disclose the transmission of image data attached to the e-mail to the receiving apparatus via the network. However, it is well known in the art that image data may be transmitted as an attachment to an e-mail message. It is common practice to transmit a document or a picture via e-mail by scanning the document or picture and attaching it to the e-mail, and in such a case the attached document is inherently converted into a format for e-mail transmission. By providing for the transmission of scanned image data as an attachment, a greater variety of image data can be transmitted for immediate reception at the receiving apparatus, and thus it would have been obvious to modify the teaching of Lee by providing a scanner for inputting image data so that the image data may be transmitted as an attachment to an e-mail message, as is well known in the art.

Lee does not disclose a memory configured to store a default mail address and a mail address of at least one user; or the controller configured to set the default mail address into the mail message of the e-mail to which the image data is attached when the mail address of the user is not selected by the panel section; or that the default mail address is pre-stored in the memory and the mail address of the user is stored in the memory by the user. However, it is well known in the art that a memory that stores user identification numbers for the transmission of image data can also store a default number, and that this default number can be attached to image information to be transmitted to a receiver when a user identification number is not entered. Baek discloses this limitation (column 7, lines 44-67 (the default number is the automatic dialing number "FF")). In Baek, the default mail address and the mail address are stored in the memory by the user (column 5, line 12 – column 6, line 16). Since new mail addresses may be stored at any time (column 5, lines 52-61), it can be said that all mail addresses, including the default mail address, stored prior to the registration of the new mail address are "pre-stored." It would have been obvious to one of ordinary skill in the art that by providing a default number, a user may be able to transmit image data, either on behalf of himself or herself, or on behalf of the company for which he or she works, and that a person receiving the image data can positively identify the company sending the image data even if a user at the transmitting end fails to enter identification information, and thus it would have been obvious for one of ordinary skill in the art to modify the teaching of Lee by providing a memory configured to store default



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information, and a controller configured to set the default information, as disclosed in Baek.

Claims 28-45 are method claims corresponding to above-rejected apparatus claims 1, 5, 6, 7, 11, 12, 13, 17 and 18-27, respectively. The method steps are either disclosed in Lee, or would have been obvious to one of ordinary skill in the art in view of Baek, as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Thomas D Lee', with a stylized, looping flourish at the end.

Thomas D Lee  
Primary Examiner  
Technology Division 2625

tdl  
September 22, 2006